

Appl. No. 09/766,774
Amdt. dated June 26, 2003
Reply to Office Action of March 26, 2003

REMARKS/ARGUMENTS

This Amendment is submitted in response to the Office Action mailed March 26, 2003. At that time, claims 1, 2, 6, and 9 were pending in the application. In the Office Action, the Examiner indicated that claim 2 contained patentable subject matter. However claims 1, 2, 6, and 9 were rejected under the enablement requirement of 35 U.S.C. §112, first paragraph. Claim 1 was further rejected under 35 U.S.C. §102(e) as being anticipated by U. S. Patent No. 6,319,747 issued to Todisco *et al.* (hereinafter "Todisco"). Claims 6 and 9 were also rejected under 35 U.S.C. §103(a) as being unpatentable over Todisco.

By this amendment, various paragraphs of the specification have been changed, claims 1, 2, 6, and 9 have been amended, and an additional drawing has been submitted. Accordingly, claims 1, 2, 6, and 9 are presented for reconsideration by the Examiner.

The Applicant would also like to thank Examiner Peterson for the telephonic interview conducted on June 23, 2003, with the Applicant's attorneys, Evan R. Witt and Kyle W. Grimshaw. During the interview, the parties discussed the enablement rejection of claims 1, 2, 6, and 9 as well as the anticipation rejection of claim 1. In discussing the enablement issue, it was agreed that the Applicant would submit a formal response outlining the Applicant's arguments as to why claims 1, 2, 6, and 9 are sufficiently enabled. It was also agreed that the Applicant would submit an additional informal drawing showing an embodiment of the invention in which the buffer plate 10 may directly contact or attach to the lift piece 7.

With respect to the anticipation rejection of claim 1, the Examiner suggested two possible amendments to claim 1 as a means of distinguishing the presently claimed invention over Todisco. The Applicant would like to thank the Examiner for these helpful suggestions and notes that the substance of one of these suggestions has been presently incorporated into claim 1.

OBJECTION TO CLAIMS 2 AND 6

The Office Action objected to claims 2 and 6 on grounds that the term "the lift piece" recited in these claims lacked a proper antecedent basis. See Office Action ¶ 2. By this paper,

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claims 2 and 6 have been amended to correct for this informality and as such, the Applicant respectfully requests that this objection be withdrawn.

AMENDMENTS TO THE DRAWINGS AND THE SPECIFICATION

In accordance with the Examiner's instructions in the telephonic interview, the Applicant has submitted an additional informal drawing (Figure 11) illustrating the embodiment of the invention in which the buffer plate 10 may directly contact the lift piece 7. Corresponding sections of the specification that relate to the new Figure 11 have also been amended. Figure 11 is patterned after the illustration of Figure 3 and is supported by claim 1 and page 6, line 20 of the specification. As such, these changes to the drawings and specification do not constitute new matter. *See e.g., Schering Corp. v. Amgen Inc.*, 55 USPQ2d 1650, 1654 (by definition, all material that is supported by the initial disclosure is not new matter).

REJECTION OF CLAIMS 1, 2, 6, AND 9 UNDER 35 U.S.C. 112, FIRST PARAGRAPH

As noted above, the Office Action rejected claims 1, 2, 6, and 9 under the enablement requirement of 35 U.S.C. §112, first paragraph. *See* Office Action ¶ 1. More specifically, the Office Action stated that it was not clear how the embodiment described on page 6, line 20 of the specification in which the buffer plate 14 directly contacts the lift piece 7 was held together, and as a result, one of ordinary skill in the art would not be enabled to make and use this embodiment of the present invention. *See id.* In response, the Applicant respectfully traverses this rejection.

The enablement requirement of §112, first paragraph requires that the patent teach the invention with sufficient precision and clarity such that based upon the teachings of the patent and his or her own skill and knowledge, one of ordinary skill in the art would be able to make and use the present invention without undue experimentation. *See e.g., United States v. Telectronics, Inc.*, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988); MPEP §2164.01. A patent satisfies the enablement requirement even if some experimentation or modification of the disclosure is necessary to make or use the invention, provided that the amount of such experimentation is not undue. *See e.g., In re Wands*, 8 USPQ2d 1400, 1403-1404 (Fed. Cir. 1988). Additionally, in

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considering the enablement requirement, it needs to be remembered that patents are written to those of ordinary skill in the art, as a such, the patent "need not teach, and preferably omits, what is well known in the art." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986) (emphasis added).

In the present case, the Examiner is correct is stating that there is no explicit teaching of how the embodiment described on page 6, line 20 is held together. However, the Applicant submits that various methods and means for connecting or joining together two plates are well known and commonly used in the art. In fact, the present specification itself teaches the use of screws, clamps, and magnets as a means of connecting together two plates. Accordingly, using this knowledge in conjunction with his or her own skill and the teachings of the present specification, one of ordinary skill in the art could easily make the disclosed embodiment by modifying the buffer plate 14 so that it may directly contact and/or be attached together with the lift piece 7. As a result, the present claims satisfy the enablement requirement of §112, first paragraph. Withdrawal of this rejection is respectfully requested.

REJECTION OF CLAIM 1 UNDER 35 U.S.C. §102(e)

The Examiner rejected claim 1 under 35 U.S.C. §102(e) as anticipated by Todisco. *See* Office Action ¶ 4. The Applicant respectfully traverses this rejection.

It is well settled that an "invention is anticipated [under §102(e)] if . . . all the claim limitations [are] shown in a single art prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim. The identical invention must be shown in as complete detail as is contained in the patent claim." *Richardson v. Suzuki Motor Co., Ltd.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). *See also* MPEP §2131.

The Applicant finds significant features and elements that are not taught or disclosed by Todisco. For example, the preamble of claim 1 states that the present invention is designed to "form[] a plurality of V-shaped grooves at a desired interval on a light guide panel." Todisco does not teach anything related to forming grooves in a light guide panel; rather, Todisco teaches that a tool 50 that is designed to cut through and/or separate various layers of a thin film solar

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module. *See e.g.*, Todisco Col. 6, lines 16-37. There does not appear to be any teaching, suggestion, or motivation in the cited prior art to use Todisco's cutting tool to cut V-shaped grooves on a light guide panel.

Additionally, claim 1 also includes the limitation that the buffer plate has an "elastic member fixed in a groove located in the lower side of the buffer plate." To the extent that Todisco's tool 50 and spring 70 may be respectfully considered a buffer plate and an elastic member, there is no teaching or disclosure in Todisco that the spring 70 is fixed in a groove on the lower side of the tool 50. On the contrary, Todisco's Figure 10 clearly shows that the spring 70 is positioned on the upper side of the tool 50.

Therefore, because Todisco does not teach the "identical invention ...in as complete detail as is contained in" claim 1, Todisco does not anticipate this claim under §102(e). Withdrawal of this rejection is respectfully requested.

REJECTION OF CLAIMS 6 AND 9 UNDER 35 U.S.C. §103(a)

The Examiner rejected claims 6 and 9 under 35 U.S.C. §103(a) as being unpatentable over Todisco. *See* Office Action ¶ 6. The Applicant respectfully traverses this rejection.

It is well settled that if an independent claim is patentably distinct from the cited references, then all claims depending from that independent claim are likewise patentable. *See e.g., In re Royka and Martin*, 180 USPQ 580, 583 (CCPA 1974); *Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593, 1604 n.36 (Fed. Cir. 1987); *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). In this case, claims 6 and 9 depend from independent claim 1, which as noted above, is patentably distinct from Todisco. Accordingly, dependent claims 6 and 9 are likewise patentable over Todisco. Withdrawal of this rejection is respectfully requested.

FINAL REJECTION

Even though the Office Action was labeled "Final," the grounds for rejection were new and the prior art was newly cited. The Applicant is entitled to respond to the new grounds of

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rejection by submitting appropriate amendments and arguments. Entry of the foregoing amendments is requested.

CONCLUSION

The Applicant respectfully asserts that claims 1, 2, 6, and 9 are in a form for immediately allowance. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "E. R. Witt", written over a horizontal line.

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